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IBM Corporation
Intellectual Property Law
2455 South Road, P386
Poughkeepsie, NY 12601

EXAMINER

PATEL, DHAIRYA A

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,227

Applicant(s)

GOODMAN ET AL.

Examiner

Dhairya A. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/9/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication filed on 11/30/2005.
2. This amendment has been considered and entered.
3. Claims 30-33 are newly added claims.

Response to arguments

4. Applicant's arguments have been deemed moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1,4,10,11,14,20,21,23,31,33 are rejected under 35 U.S.C. 102(e) as being anticipated by Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman).

As per claim 1, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

-receiving at a second client , a first message from a first client, the first client having a first network address (column 5 lines 32-42)

The reference teaches second user receiving a first message from the first user, and receiving the message body and the address of the first client.

-creating at the second client, a second message, the second message comprising the first message and the first network address (column 9 lines 43-67)(Fig. 16-19);

The reference teaches second user responding, and sending a second message "Hi John" comprising the first message which is "hello Mary" and the first address of "mroe1934" (first network address)

-transmitting the second message by way of an instant message application from the second client to the first client (Fig. 16-19) (column 9 lines 30-66);

The figures show that second message "Hi john" is sent by instant message application from the second client to the first client.

-retrieving additional information related to the second client (Fig. 9)(column 6 lines 1-7)(column 5 lines 46-65); and

The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-presenting the second message and the additional information at the first client (Fig. 16-19)(column 9 lines 43-67)(Fig. 9).

The figures presenting the second message "Hi John" with online status field such as time stamp (additional information) at the client in (Fig. 16-19) "13:20:27 mroe 1934" at the client window.

As per claim 4, Appelman teaches the method according to claim 1 wherein the additional information comprises any one of a first user name, first user title, first user telephone number, first user job responsibility, first user secretary (Fig. 16)(column 25-42); and

The reference teaches first user name which "John" or "mroe1934" (first user name).

As per claim 10, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

- creating at a first client (Fig. 15 element 600), a first message (Fig. 15 element "Hello Mary"), the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title, a user telephone number, a user value, a user job responsibility or information about a user's secretary (Fig. 15-16)(column 9 lines 25-42);

The reference teaches creating a message the first client a first message "Hello Mary", the first message comprising the a user value (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

- transmitting the first message by way of an instant message application from the first client to a second client (column 9 lines 25-42) (Fig. 15-16);

The reference teaches transmitting the first message by instant message application from first client to the second client.

-retrieving at the second client, the additional information (Fig. 16)(column 25-42); and

The reference teaches at the second client (Fig. 16) receiving (Fig. 16 element "more1934" or "13:20:05" time stamp) (additional information) at the second client.

-presenting the first message and the additional information at the second client (Fig. 16)(column 25-42).

The figure 16 teaches presenting the first message "Hello Mary" and the additional information (13:20:05 or mroe1934), which is a time stamp and a user value.

As per claim 11 respectively, teaches same limitations as claim 1 respectively, therefore rejected under same basis.

As per claim 14 respectively, teaches same limitations as claim 4 respectively, therefore rejected under same basis.

As per claim 20 respectively, teaches same limitations as claim 10 respectively, therefore rejected under same basis.

As per claim 21, Appelman teaches a system for electronic instant message conversation, the system comprising:

- a network (Fig. 1 element 127);
- a first client in communication with the network (Fig 9);
- a second client in communication with the network (Fig. 9), wherein the clients include instructions to execute a method comprising:

-receiving at a second client , a first message from a first client, the first client having a first network address (column 5 lines 32-42)

The reference teaches second user receiving a first message from the first user, and receiving the message body and the address of the first client.

-creating at the second client, a second message, the second message comprising the first message and the first network address (column 9 lines 43-67)(Fig. 16-19);

The reference teaches second user responding, and sending a second message "Hi John" comprising the first message which is "hello Mary" and the first address of "mroe1934" (first network address)

-transmitting the second message by way of an instant message application from the second client to the first client (Fig. 16-19) (column 9 lines 30-66);

The figures show that second message "Hi john" is sent by instant message application from the second client to the first client.

-retrieving additional information related to the second client (Fig. 9)(column 6 lines 1-7)(column 5 lines 46-65); and

The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-presenting the second message and the additional information at the first client (Fig. 16-19)(column 9 lines 43-67)(Fig. 9).

The figures presenting the second message "Hi John" with online status field such as time stamp (additional information) at the client in (Fig. 16-19) "13:20:27 mroe 1934" at the client window.

As per claim 23 respectively, teaches same limitations as claim 4 respectively, therefore rejected under same basis.

As per claim 31, Appelman teaches the method according to claim 4, wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link (such as a URL). (Fig. 15-16)(column 9 lines 25-42);

The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

As per claim 33, Appelman teaches the method according to claim 10, wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link such as a URL, a telephone message or command information for actuating a mechanical a device. (Fig. 15-16)(column 9 lines 25-42);

The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3,5-9,12-13,15-19,22,24-30,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Kapil et al. U.S. Patent # 6,941,345 (hereinafter Kapil).

As per claim 2, Appelman teaches the method according to claim 1 but is silent on teaching wherein the first message is received at the second client from the first client by way of a Publish/Subscribe server. Kapil teaches the first message is received at the second client from the first client by way of a Publish/Subscribe server (column 4 lines 16-28).

. The reference teaches receiving a request message from the user A (receiving first message from the first user) and the request message is sent to the service provider in the community (pub/sub channel of a pub/sub service), the community comprising plurality of users (Fig. 5) belonging to the community, and the community comprising user B (second users) and presenting the message at user B's terminal (second client)(column 4 lines 16-49). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with receiving message from the first client at the second client by the way of publish/subscribe server. The motivation for doing so

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would have been so that the second user has an option to accept a message or to check if the second user is online or the second user exists because the message is sent to the service provider in the second community (Publish/subscribe server) which checks if the second user exists and if he does exists passes the message to him.

As per claim 3, Appelman and Kapil teaches the method according to claim 1, but is silent on teaching further step of subscribing by any one of the first client or the second client, to a channel of a publish/subscribe server. Kapil teaches subscribing by any one of the first client or the second client, to a channel of a publish/subscribe server (column 4 lines 16-49) (Fig. 1 element "community A" or "community B"). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with having first client or second client subscribe to a channel of publish/subscribe server. The motivation for doing so would have been so that first user or second user can communicate to other user belonging to the same community (publish/subscribe server) or even other community.

As per claim 5, Appelman teaches the method according to claim 1 but fails to teach wherein any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator. Kapil teaches any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator (Column 5 lines 52-64)(column 6 lines 12-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to

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implement Kapil's teaching in Appelman's teaches to come up with having first message or second message translated into any one of telephone message, a video display an audio message. The motivation for doing so would have been so that if the user does not have access to a computer to receive the first message or second message, he/she can still receive by a telephone message or audio message.

As per claim 6, Appelman teaches a method for identifying a message initiator in a system for instant message using a pub/sub server, the method comprising the steps of:

- obtaining at a first client, first user identifying information (column 5 lines 46-65)(column 6 lines 1-6)(Fig. 9);

The figure teaches obtaining at the first client, the buddy list and the information about the first user identifying information "mroe1934" and his online status field.

- incorporating the first user identifying information in a message to be published (Fig. 16-19)(column 9 lines 43-67)(Fig. 9).

The figures presenting "mroe1934" and his online status field such as time stamp (first user identifying information) in the message at the first client in (Fig. 16-19) "13:20:05 mroe1934" to be published.

Appelman fails to teach transmitting the message to a pub/sub server; publishing the message to subscribers of the pub/sub server; and providing the message comprising the first user information to a subscriber. Kapil teaches transmitting the message to a pub/sub server (column 4 lines 16-28), publishing the message to subscribers of the pub/sub server (column 9 lines 20-35), providing the message

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comprising the first user information to a subscriber (column 12 lines 35-51)(column 10 lines 19-36, lines 39-48). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with having transmitting, publishing the message to a pub/sub server and providing the message comprising user information to a subscriber. The motivation for doing so would have been so that the second user has an option to accept a message or to check if the second user is online or the second user exists because the message is sent to the service provider in the second community (Publish/subscribe server) which broadcasts the message and checks if the second user exists and if he does exists passes the message to him.

As per claim 7, Appelman and Kapil teaches the method according to claim 6 but Appelman further teaches wherein the providing step comprises the further steps of: acquiring second user information based on the first user identifying information in the message (Fig. 9)(column 6 lines 1-7)(column 5 lines 46-65); and

The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-providing the second user information to the subscriber (Fig. 16-19)(column 9 lines 43-67)(Fig. 9).

As per claim 8, Appelman and Kapil teaches the method according to claim 6 but Kapil further teaches wherein the obtaining step comprises the further step of: transforming user information from any one of instant message, text, audio, video or voice into the digital message (column 5 lines 52-65).

As per claim 9, Appelman and Kapil teaches the method according to claim 6 but Appelman further teaches wherein the presenting step comprises the further step of: transforming the message to any one of instant message, text, audio or video (Fig. 16-19)

The reference teaches the transforming the message into instant message.

As per claims 12-13,15 respectively, teaches same limitations as claims 2-3,5 respectively, therefore rejected under same basis.

As per claims 16-19 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

As per claims 22,24 respectively, teaches same limitations as claims 2,5 respectively, therefore rejected under same basis.

As per claim 25, Appelman teaches a system for identifying a message initiator in a system for instant message using a pub/sub server, the system comprising:

a network(Fig. 1 element 127);

a first client in communication with the network, wherein the clients include instructions to execute a method comprising (Fig. 9):

-obtaining at a first client, first user identifying information (column 5 lines 46-65)(column 6 lines 1-6)(Fig. 9);

The figure teaches obtaining at the first client, the buddy list and the information about the first user identifying information "mroe1934" and his online status field.

-incorporating the first user identifying information in a message to be published (Fig. 16-19)(column 9 lines 43-67)(Fig. 9).

The figures presenting "mroe1934" and his online status field such as time stamp (first user identifying information) in the message at the first client in (Fig. 16-19) "13:20:05 mroe1934" to be published.

Appelman fails to teach a pub/sub server; transmitting the message to a pub/sub server; publishing the message to subscribers of the pub/sub server; and providing the message comprising the first user information to a subscriber. Kapil teaches a pub/sub server (column 4 lines 16-28); transmitting the message to a pub/sub server (column 4 lines 16-28), publishing the message to subscribers of the pub/sub server (column 9 lines 20-35), providing the message comprising the first user information to a subscriber (column 12 lines 35-51)(column 10 lines 19-36, lines 39-48). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with having transmitting, publishing the message to a pub/sub server and providing the message comprising user information to a subscriber. The motivation for doing so would have been so that the second user has an option to accept a message or to check if the second user is online or the second user exists because the message is sent to the service provider in the second community (Publish/subscribe server) which broadcasts the message and checks if the second user exists and if he does exists passes the message to him.

As per claims 26-28 respectively, teaches same limitations as claims 7-9 respectively, therefore rejected under same basis.

As per claim 29, Appelman teaches a system for electronic instant message conversation, the system comprising:

a network (Fig. 1 element 160);
a first client in communication with the network, wherein the clients include instructions to execute a method comprising:

-creating at a first client (Fig. 15 element 600), a first message (Fig. 15 element "Hello Mary"), the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title, a user telephone number, a user value, a user job responsibility or information about a user's secretary (Fig. 15-16)(column 9 lines 25-42);

The reference teaches creating a message the first client a first message "Hello Mary", the first message comprising the a user value (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

-transmitting the first message by way of an instant message application from the first client to a second client (column 9 lines 25-42) (Fig. 15-16);

The reference teaches transmitting the first message by instant message application from first client to the second client.

-retrieving at the second client, the additional information (Fig. 16)(column 25-42); and

The reference teaches at the second client (Fig. 16) receiving (Fig. 16 element "more1934" or "13:20:05" time stamp) (additional information) at the second client.

-presenting the first message and the additional information at the second client (Fig. 16)(column 25-42).

The figure 16 teaches presenting the first message "Hello Mary" and the additional information (13:20:05 or mroe1934), which is a time stamp and a user value.

Appelman fails to teach a pub/sub server. Kapil teaches a pub/sub server (column 4 lines 16-28). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with a system having a pub/sub server. The motivation for doing so would have been so that the service provider in the community (pub/sub server) can check if the user exists and if so the message can be sent to the user or to check if the receiving user wants to accept the message.

As per claim 30, Appelman teaches the method according to claim 1, but fails to teach each comprising the further steps of: associating the second client with a channel of a publish/subscribe server; the first client sending the first message to the channel of the publish/subscribe server; determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client; and the publish/subscribe server publishing the first message to the determined plurality of subscribers.

Kapil teaches associating the second client with a channel of a publish/subscribe server (column 12 lines 9-32);

-the first client sending the first message to the channel of the publish/subscribe server (column 4 lines 16-49);

- determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client (column 12 lines 33-51); and

- the publish/subscribe server publishing the first message to the determined plurality of subscribers (column 4 lines 16-49)(column 12 lines 9-51).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman's teaching to come up with associating second client with the pub/sub server and first client send the message, and pub/sub server publishing the message to the subscribers. The motivation for doing so would have been so that first user can check through the service provider in the community (pub/sub server) that the a user exists and send a message, and if the user can have a conversation with the first user.

As per claim 32, Appelman and Kapil teaches the method according to claim 6, but Kapil further teaches wherein the transmitting step comprises the further steps of:

- the first client associating the first message to be transmitted with a channel of the pub/sub server (column 12 lines 9-32);

- the pub/sub server determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client (column 12 lines 33-51); and

- the pub/sub server receiving the first message from the first client (column 4 lines 16-49);

wherein the publishing step comprises the further step of publishing the first message to the plurality of subscribers associated with the channel of the pub/sub server (column 4 lines 16-49)(column 12 lines 9-51).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Voice Instant messaging" by Wu et al. U.S. Patent Publication # 2002/0023131 A1.

B) "Video Messaging" by Enete et al. U.S. Patent Publication # 2003/0208543 A1.

8. A shortened statutory period for response to this action is set to expire **3 (three) Months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A. Patel whose telephone number is 571-272-5809. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER